VIA EFS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of: Pierattilio DI GREGORIO			
Conf. No.:	2819	Group Art Unit:	1732
Appln. No.:	10/811,604	Examiner:	Patrick Butler
Filing Date:	March 29, 2004	Attorney Docket No.:	6023-175US(BX2592M)
Title:	METHOD FOR PRODUCING THERMO-INSULATING CYLINDRICAL VACUUM PANELS AND PANELS THEREBY OBTAINED		

REQUEST FOR RECONSIDERATION

This is in response to the Office Action dated August 23, 2006 (Paper No. 20060817) in the above-identified patent application. This response is being timely filed by November 24, 2006 (November 23, 2006 being a Federal Holiday).

The Examiner has rejected claims 1-4, 7, 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,107,649 of Benson et al. ("Benson") in view of U.S. Patent 5,792,539 of Hunter, U.S. Patent 6,189,354 of Späth and Applicant's own admission at page 1, paragraph [0005] of the specification. Further, the Examiner has rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Benson in view of Hunter, Späth, Applicant's own admission and U.S. Patent 6,336,693 of Nishimoto. Finally, the Examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Benson in view of Hunter, Späth, Applicant's own admission, and U.S. Patent 4,011,357 of Haase. The Examiner's contentions and arguments in support of the rejections are essentially the same as in previous Office Actions.

These rejections are again respectfully but strenuously traversed for the reasons set forth below, Applicant's arguments in response to previous Office Actions, and particularly the Declaration of Paolo Manini under 37 C.F.R. § 1.132 ("Declaration" or "Manini Declaration"), submitted with the Amendment filed August 7, 2006. Applicant has previously addressed each of the Examiner's rejections point by point and fully discussed all of the prior art relied upon by the Examiner. Therefore, the details of the rejections and prior art will not be discussed again

here. Instead, the following remarks of Applicant are directed to the Examiner's Response to Arguments set forth at pages 8-12 of the Office Action.

It is the Examiner's position that the "affidavit" under 37 C.F.R. § 1.132 (i.e., the Manini Declaration) is insufficient to overcome the rejections under 35 U.S.C. § 103(a). In sum, the Examiner concludes that "the totality of the rebuttal evidence of non-obviousness fails to outweigh the evidence of obviousness." Applicant strenuously disagrees.

First, at the top of page 8 of the Office Action, the Examiner argues that the affidavit refers only to "the system described in the above-referenced application" and not to the individual claims of the application. The Examiner contends that there is no showing that the objective evidence of non-obviousness is commensurate in scope with the claims.

This argument is both incorrect and irrelevant. The Examiner has missed the entire point of the Manini Declaration. As stated in paragraph 6 of the Declaration, it was submitted in order to correct erroneous assumptions, misunderstandings and faulty reasoning of the Examiner in the obviousness rejections and to demonstrate the non-obviousness of the presently claimed invention over the prior art relied upon by the Examiner. There was no attempt to submit data, comparative results or the like, so that being "commensurate in scope with the claims" has no relevance to the present situation.

In any event, nowhere in the Declaration does Mr. Manini refer to "the system described in the above-referenced application." He repeatedly refers to "the presently claimed invention" or "the invention" for short (see for example, paragraphs 6, 11, 15, 16, 19, 20 and 26).

Next, the Examiner repeatedly refers to "indications of the affidavit" or "indications of the declaration." Similarly, the Examiner repeatedly declares that "appropriate weight is given to the opinion evidence. However, no factual evidence has been made of record ...." Evidently, the Examiner has treated the Declaration as merely the opinion of Mr. Manini and refuses to give the Declaration any weight as factual evidence. This is clearly improper.

While Mr. Manini has admittedly not presented any data or experimental results in his Declaration, that does not make the Declaration any less factual. Mr. Manini's statements of fact are based upon his twenty years of experience in the business of vacuum insulation panels (VIPs)

and vacuum thermal insulation, both in his various positions with SAES Getters S.p.A. (a recognized leader in the VIP art) and in his outside activities with various trade associations and technical organizations in the VIP art. This experience is set forth in detail at paragraph 3 of the Declaration. As pointed out at the bottom of page 4 of the Amendment of August 7, 2006, Mr. Manini provided factual evidence in Declaration paragraphs 11, 12, 14, 15, 16e, 17, 20, 22, 23, 24 and 26, for example, rebutting erroneous assumptions and reasoning of the Examiner.

Moreover, to the extent that Mr. Manini's Declaration is considered opinion or interpretation, such opinion and interpretation are based on Mr. Manini's educational background, training, work experience and many years working in the art of the present invention, such that Mr. Manini is considered an expert in the field of thermo-insulating vacuum panels and the production thereof.

Against the factual evidence of the Declaration and the expert opinions and interpretation of Mr. Manini, the Examiner has presented no factual evidence in response. Clearly, the Manini Declaration rebutted the Examiner's arguments of obviousness. To the extent that the Examiner may have established a *prima facie* case of obviousness (which Applicant does not admit), Applicant clearly shifted the burden back to the Examiner by submitting the Manini Declaration. In response, the Examiner submitted no new or factual evidence, but had the temerity to substitute his own opinions and speculation for the factual evidence and expert opinion of Mr. Manini.

The factual and interpretation errors and assumptions made by the Examiner are too numerous to respond to every one. Many of them have already been rebutted by the Manini Declaration, but the Examiner steadfastly holds to these errors and misconceptions without citing any factual evidence in support. Many of the Examiner's assertions fly in the face of the very prior art references upon which he relies. A few examples will suffice:

In his discussion of point 2(a) at page 10 of the Office Action, the Examiner concludes: "[f]urther, it is not clear how it follows that Hunter requires evacuation." The requirement of evacuation should be clear from a simple reading of the Hunter patent, particularly at column 6, lines 33-67. This paragraph not only clearly mentions evacuation in lines 36-39 and following, by reciting the terms "evacuation," "evacuated" or "vacuum" at least six times, but also explains

that the corrugated elements 12 "may have openings 16 (see Fig. 7) to permit the removal of gases trapped in the spaces formed by the stacked thermal insulation elements."

In the discussion of point 3(b) at page 10 of the Office Action, the Examiner contends that no factual evidence has been made of record showing that the sheet of Benson would fail below the minimum thickness. However, as pointed out by the Manini Declaration, this is clear common sense. As already pointed out many times, Benson teaches that the metal sheets forming the envelope should be sufficiently hard and rigid not to form around the spherical spacers of glass or ceramic (column 6, lines 52-53). Therefore, there is no reason why one skilled in the art, upon reading Benson, would think of reducing the thickness under the minimum value indicated therein, which is twice the maximum thickness of the barrier sheet of the presently claimed invention (see Manini Declaration paragraph 19).

In discussing item 4(a) at the top of page 11 of the Office Action, the Examiner states that "the foam is incorporated into Benson's structure." To the contrary, Benson mentions at column 2, lines 26-53 various prior art panels with a filler, but concludes that they do not give good results. The invention of Benson is a panel using discrete spacers of the envelope sheets. The Examiner's interpretation of the foam being incorporated in panels according to Benson is therefore absolutely arbitrary and contrary to the teachings of Benson.

As noted above, these errors are merely exemplary of the mistakes and misinterpretations made by the Examiner in the prior art rejections and blindly repeated in the face of the factual evidence and expert opinions and interpretations to the contrary by Mr. Manini in his Rule 132 Declaration. The Examiner's failure to give full weight and credence to the Manini Declaration is clear error in the absence of factual evidence to refute or raise reasonable doubt about Mr. Manini's statements. If the Examiner continues to maintain his interpretations of the prior art references with respect to the points testified to by Mr. Manini, the Examiner is requested to provide an affidavit and/or other credible evidence to refute Mr. Manini's testimony.

In view of the above Remarks, it is submitted that the totality of the rebuttal evidence of non-obviousness (in particular the facts and opinions of the Manini Declaration) clearly outweigh the evidence of obviousness, which consists of no more than a strained combination of four or five prior art references supported by erroneous assumptions and misinterpretations by the Examiner. Accordingly, any possible *prima facie* case of obviousness has clearly been

overcome by the Manini Declaration, so that the rejections are improper. Reconsideration and withdrawal of the rejections and an early Notice of Allowance are respectfully solicited.

Respectfully submitted,

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November 22, 2006 By: _____
(Date)

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